

Application No. 09/329,606

PATENT

REMARKS**35 U.S.C. 103(a)**

The Examiner has rejected claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Schneck et al., U.S. Pat. No. 6,260,039 and claims 6-20 under 35 U.S.C. 103(a) as being unpatentable over Schneck et al., U.S. Pat. No. 6,260,039 in view of Call, U.S. Pat. No. 6,154,738.

Claims 1-5

The examiner proposed that it would have been obvious to one ordinary skilled in the art at the time the invention was made to implement the claimed invention because Schneck teaches the substantial features of the claimed invention. Applicant respectfully disagrees and sets forth the following reason:

With respect to claim 1, Schneck fails to teach, describe, or suggest the following limitation:

“a directory of identifiers to a plurality of services;”

In regard to this limitation, the Examiner stated that Schneck teaches “a method/system comprising storing identifiers of a plurality of services.” Applicant respectfully disagrees. The references cited only show a method and system of mapping a DAP directory listing of names and organizational information to a web interface. The data stored in Schneck’s directory are

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contact information and organizational information. They do not reference any service external to the directory. Applicant thus asserts that Schneck fails to teach a substantial feature of the claimed invention.

MPEP §2143 states:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Since Schneck fails to teach a substantial feature of the claimed invention, it fails to meet the third criteria for establishing a *prima facie* case of obviousness. Furthermore, with respect to the first criteria, Applicant disagrees with the Examiner's assertion that it is common knowledge in the art to modify Schneck's invention into the claimed invention. Applicant asserts that the modification would be substantial because it would involve changing the essential function of Schneck's invention. One modification would involve reworking Schneck's directory. Schneck's teaching is directed at a system for accessing directory information for incoming requests. The data in the directory are the only end results possible for all requests, albeit the display of information may be customized. In contrast, the directory information of the claimed invention is not the end result of the incoming requests. Claim 1 has the limitation “an engine for receiving requests to access said services.” Thus the requests access the services identified in the directory, not the information in the directory itself. Applicant asserts that the modification to the Schneck's directory must involve changing its essential function (storing information to storing identifiers to plurality of services). Furthermore, even if a person of ordinary skill were to modify the function directory, there still remains the unobvious task of modifying the request

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engine in Scheck to make it direct requests "to access said services", as in the claimed invention. Unlike the claimed invention, every client request in Schneck is required to have a static URL reference pointing to a DAP (directory) data destination (col. 4 lines 24-29, 48-50, 53-55, 58-60). Therefore, Applicant submits that the requirements to change Schneck's system into the claimed invention are not common knowledge in the art. As this third criteria also cannot be met, a *prima facie obviousness* cannot be established. Applicant submits that the 103(a) rejection on claim 1 has been overcome.

As claims 2-5 depend from claim 1 or another claim that depends on claim 1, these claims are in a condition for allowance as well. Their rejection based upon 35 U.S.C. 103(a) has been overcome.

Claims 6-10

The examiner proposed that it would have been obvious to combine Schneck and Call to make the claimed invention. Applicant respectfully disagrees and sets forth the following reason:

With respect to claim 6-10, Call does not teach the directory limitation of claim 1 that Schneck fails to teach. Thus, even in combination with Call, the prior art does not teach all the limitations of claim 1 and a *prima facie obviousness* cannot be established. As claims 6-10 all depend on claim 1, Applicant asserts that their rejection based on 103(a) is overcome.

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Claim 11 overcomes the 103(a) rejection for the same reason as claim 1. Neither Schneck nor Call teaches the limitation of storing identifiers in a directory. For this reason, Claim 11 overcomes the 103(a) rejection.

As claims 12-20 depend on claim 11, Applicant submits that they are in a condition of allowance as well.

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CONCLUSION

The Examiner has rejected claims 1-20 under 35 U.S.C. 103(a) and objected to the drawings. In response, Applicant has corrected the drawings and responded to the 35 U.S.C. 103(a) rejection on claims 1-20. Applicant asserts that the present application is in a condition for allowance.

Respectfully submitted,

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